

The opinion in support of the decision being
entered today is not binding precedent of the Board.

Paper 100

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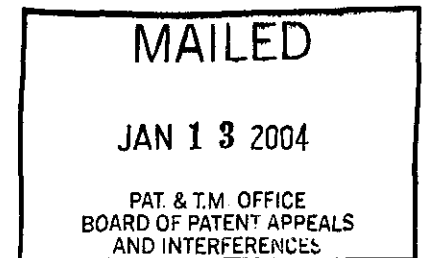
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ELLEN MOSLEY, RAYMOND K. WHITBY
and VERA OWEN
Junior Party,
(Patent 5,752,945),

v.

RICHARD N. DODGE, II, CLIFFORD J. ELLIS,
CONNIE L. HETZLER, ERIC S. KEPNER,
SYLVIA B. LITTLE, LAWRENCE H. SAWYER
and CANDACE D. KRAUTKRAMER
Senior Party,
(Application 09/314,492).



Patent Interference No. 104,781

Before: SCHAFER, LEE and SPIEGEL, Administrative Patent Judges.
SCHAFER, Administrative Patent Judge.

FINAL JUDGMENT

During telephone conferences held December 22, 2003, and January 5, 2004, each of the parties has acknowledged that their respective involved claims were unpatentable in light of certain prior art. In light of these concessions, there is no apparent reason to continue this interference. Based on the following findings of fact, we issue a final judgment against both parties.

Findings of Fact

- F. 1. This interference is between U.S. Patent 5,752,945 to Mosley et al. and reissue Application 09/314,492 of Dodge et al. Paper 1.
- F. 2. The Mosley patent issued from Application 08/846,003, filed 25 April 1997.
- F. 3. The Dodge application is a reissue of Dodge Patent 5,820,973. Application 09/314,492, Declaration for Reissue Patent Application For Richard Norris Dodge, II.
- F. 4. Dodge was accorded the benefit of the 22 November 1996 filing date of Application 08/754,417, which issued as the Dodge Patent. Paper 89, p.24.
- F. 5. The sole count of this interference is

Count 2

Claim 1 of Mosley patent 5,752,945

or

Claim 25 of Dodge Application 09/314,492 wherein said at least one first surge layer and said at least one second surge layer are bonded together.

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- F. 6. The claims of the parties which correspond to Count 1 are:

Dodge	25-29
Mosley	1-10

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- F. 7. The claims of the parties which do not correspond to Count 1, and therefore are not involved in this interference, are:

Dodge	None
Mosley	None

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- F. 8. Dodge Claims 25-29 were included in Application 09/314,492 to provoke an interference with the Mosley patent. Application 09/314,492, Declaration for Reissue Patent Application For Richard Norris Dodge, II, p. 2.
- F. 9. Dodge Claims 25-29 were said to be "copied or substantially copied from Mosley's involved patent for the purpose of interference." Application 09/314,492, Declaration for Reissue Patent Application For Richard Norris Dodge, II, p. 2.

We enter judgment of unpatentability against Dodge, rather than make a recommendation to the examiner under 37 CFR § 1.659(c). In light of Dodge's concession of unpatentability, we can see no purpose in merely recommending that the claims be rejected when the case returns to the examiner. However, our judgment is without prejudice to Dodge submitting amended claims and presenting evidence and argument asserting the amended claims are patentably distinct from the prior art when the application returns to the jurisdiction of the examiner.³

Under the particular circumstances of this case, we exercise our discretion and decline to enter a judgment on priority against Mosley, notwithstanding Mosley's failure to serve evidence on priority or derivation. Priority and derivation are determined based on a count representing a patentable invention claimed by each party. It is fundamental that the count must be patentable over the prior art. Due to the unpatentability of each party's claims, on the record before us, there is no basis for formulating a count directed to patentable subject matter. Without a proper count, there simply cannot be any priority determination. To award a judgment on priority for failure of Mosley to serve a priority case would, under the circumstances of this case, exhort form over substance.

JUDGMENT

It is

ORDERED that judgment as to the subject matter of Count 2 (Paper 90) is awarded against the junior party ELLEN MOSLEY, RAYMOND K. WHITBY and VERA OWEN;

FURTHER ORDERED that junior party, ELLEN MOSLEY, RAYMOND K. WHITBY and VERA OWEN is not entitled to a patent containing claims 1-10 (corresponding to Count 2) of Patent 5,752,945;

FURTHER ORDERED that judgment as to the subject matter of Count 2, is awarded against the senior party RICHARD N. DODGE, II, CLIFFORD J. ELLIS, CONNIE L. HETZLER, ERIC S. KEPNER, SYLVIA B. LITTLE, LAWRENCE H. SAWYER and CANDACE D. KRAUTKRAMER;


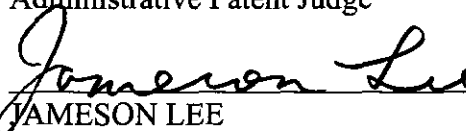
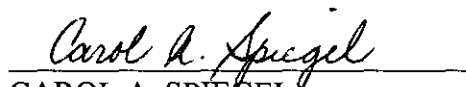
FURTHER ORDERED that senior party, RICHARD N. DODGE, II, CLIFFORD J. ELLIS, CONNIE L. HETZLER, ERIC S. KEPNER, SYLVIA B. LITTLE, LAWRENCE H. SAWYER and

³ Our statement should not be construed as an order to the examiner to allow amendment of the claims at this late stage of the prosecution. Whether further amendment shall be allowed in Dodge's application is left to the sound discretion of the examiner.

CANDACE D. KRAUTKRAMER, is not entitled to a patent containing claims 25-29 (corresponding to Count 2) of Application 09/314,492;

FURTHER ORDERED that if there is a settlement agreement and it has not already been filed, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661; and

FURTHER ORDERED that a copy of this opinion and the attached GB Patent 2,272,859A be given a file number and be placed in the files of Patent 5,752,945 and Application 09/314,492.

)	
RICHARD E. SCHAFER)	
Administrative Patent Judge)	
)	
JAMESON LEE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
CAROL A. SPIEGEL)	
Administrative Patent Judge)	

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